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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/507,086 | 01/24/2005 | Hirokazu Takeuchi | JCLA14365 | 8897 |

23900 7590 09/23/2005

J C PATENTS, INC.
4 VENTURE, SUITE 250
IRVINE, CA 92618

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| EXAMINER |
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CHERRY, EUNCHA P

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| ART UNIT | PAPER NUMBER |
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2872

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/507,086

Applicant(s)

TAKEUCHI ET AL.

Examiner

EUNCHA P. CHERRY

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 8 is/are rejected.
- 7) ☒ Claim(s) 3,5-7 and 9 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claims 5-6 are objected to because of the following informalities: in claim 5, the word "beomes" on line 8 appears to be a typographic error, perhaps the word should be "becomes". Appropriate correction is required. Also, the phrases "desired range" or "desired length" is unclear phrases, it appears "predetermined range" or "predetermined length" would overcome this objection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 2, 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohgane (US 6,511,190 B2) in view of Snyder et al (US 5,080,706).

Ohgane discloses a prism (Fig. 2A) made of transparent glass (column 6, lines 40-42) comprising prism surfaces subject

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to light (see 10), and corner portions adjacent to the prism surfaces (4 corners of prism 10), wherein a compressive stress layer having stress is formed in the surface of the corner portion (23 and 24, and see column 6, lines 34-39), wherein the optical film is formed on the prism surfaces (see 21, 22).

Ohgane does not teach the surfaces of the corner portions that are fire-polished surfaces. Snyder et al discloses the teaching of fire polishing of an optical element before bonding an additional layer to the optical element (see abstract). It would have been obvious to one of ordinary skill in the art to fire polish surfaces so that smoothness can be obtained as taught by Snyder et al.

Ohgane in view of Snyder et al discloses the claimed invention as set forth above except for the stress range. It would have been obvious to one of ordinary skill in the art to choose the range, since it has been held that where general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Allowable Subject Matter

4. Claims 3, 5-7 and 9 objected to as being dependent upon a rejected base claim (claims 3, 7 and 9) or objected (claims 5 and 6), but would be allowable if rewritten in independent form

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including all of the limitations of the base claim and any intervening claims (claims 3, 7 and 9) or re-write claims to overcome objections stated above (claims 5 and 6).

5. The following is a statement of reasons for the indication of allowable subject matter: claims are allowable at least for the reason that the prior art does not teach or reasonably suggest the prism that satisfying the conditional equation as set forth in the claimed combination.

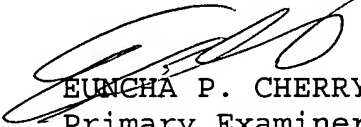
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EUNCHA P. CHERRY whose telephone number is 571-272-2310. The examiner can normally be reached on M-F 6:30-4:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DREW DUNN can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



EUNICE P. CHERRY
Primary Examiner
Art Unit 2872

9/22/05